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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DENNISON, JERRY B

ART UNIT PAPER NUMBER

2143

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,839

Applicant(s)

CLERON ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 27-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Amendment "C" for Application Number 09/607,839 received on 04 November 2004.
2. Claims 1-15 and 27-35 are presented for examination.
3. Claims 34 and 35 are new.

Response to Arguments

4. Applicant's arguments, see page 9, filed 4 November 2004, with respect to the rejection(s) of claim(s) 1-15 and 27-33 under Cotrille (U.S. 6,581,096) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-15 and 27-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made."

It is unclear to the Examiner how the decision engine knows to select content based on a client attribute if the request does not supply the client attribute and also if the request does not specify how the selection is to be made. It is unclear what the request is actually sending to the decision engine and also how the decision engine is using it. It is also unclear how the decision engine would know that the request for content is based a particular client without receiving any indication of the client from the server application. Examiner suggests rephrasing this limitation in a more clear and precise manner explaining what the invention **does** use or do rather than what it does not use or do, and also excluding any negative limitations to allow the examiner to perform a proper search and consideration on the claimed invention.

7. Claim 3 recites the limitation "said portion of script". There is insufficient antecedent basis for this limitation in the claim.

8. Claim 4 recites the limitation "requesting the decision engine to select content for the document based on attributes of the client is conducted without the server application communicating to the decision engine a value of said at least one attribute of the client." It is unclear to Examiner what **is** being communicated to the decision engine. It is suggested by the Examiner to explain what **is** being communicated rather than what is not being communicated to allow the examiner to perform a proper search and consideration on the claimed invention.

9. Claim 5 recites the limitation "requesting the decision engine to select content for the document based on attributes of the client is further conducted without the server application communicating to the decision engine criteria by which the decision engine is to select the content".

It is unclear to Examiner how this limitation is "further conducted" when it is stating the same limitation as in claim 1. It is still also unclear to Examiner for the same reasons as noted in the above rejection of claim 1.

10. Claims 7 and 8 recites, "determined to be appropriate for the client". It is unclear to Examiner how these determinations are being made.

11. Claims 9 and 27 recite the limitation "only upon processing a first portion of a script associated with the document, issuing to a decision engine, that is separate from the server application, a request for the decision engine to select a second portion of the script, wherein the selection of the second portion is based on at least one client attribute that is identified by the decision engine and that is not included with the request or script".

It is unclear to the Examiner how the decision engine identifies a client attribute without receiving it in the request or script. It is unclear to Examiner how the decision engine makes a selection based on a client attribute without receiving the client attribute. It is also unclear what the request includes. It is suggested by the Examiner

to explain what the request **does** include rather than what it does not include to allow the examiner to perform a proper search and consideration on the claimed invention.

12. Claim 11 recites the limitation "wherein the act of processing the first portion of the script and the second portion of the script comprises the act of receiving content selected by the decision engine to be appropriate for the client based on the at least one attribute of the client." It is unclear to Examiner what makes content "appropriate." If all that is meant by "appropriate" content is "based on the at least one attribute of the client", then Examiner does not see a difference between claim 11 and claim 9.

13. Claim 14 recites the limitation "the at least one attribute of the client that is to be used by the decision engine to select the second portion." It is unclear to Examiner how the decision engine identifies the at least one attribute of the client.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 and 27-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Courts et al. (U.S. 6,076,108).

14. Regarding claims 1, 9, 12, 13, and 27, Courts disclosed in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

receiving a request for a document at a server application, the server application being configured to generate the document from a script;

the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made;

the server application receiving from the decision engine an identification of the content that has been selected by the decision engine; and

transmitting the document to the client (Courts, col. 7, line 45 through col. 8, line 30, Courts disclosed a server implementation where a render engine receives a request from a client, the render engine associating a session ID with the client, the render engine sending the session ID with the client to a session manager to request session information for the SID, the information being passed back to render engine, and the render engine creating the document and transmitting it to the client. The original client request is not being passed to the session manager. The render engine request

Art Unit: 2143

includes a client session ID, which identifies the client, but does not include any attributes about the client or how to select content).

15. Regarding claim 2, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein the act of receiving the identification of the content comprises the act of receiving additional script that, when executed, results in the content being incorporated into the document (Courts, col. 8, lines 25-30).

16. Regarding claim 3, Courts disclosed the limitations, substantially as claimed, as described in claim 2, including the act of assembling the script at runtime by concatenating said portion of script and said additional script (Courts, col. 8, lines 45-50).

17. Regarding claims 4 and 5, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein:

the act of processing code associated with the script is performed by a server application operating at the server (Courts, col. 8, lines 45-50).

requesting the decision engine to select content for the document based on attributes of the client is conducted without the server application communicating to the decision engine a value of said at least one attribute of the client (Courts, col. 7, lines 60-65); and

without the server application communicating to the decision engine criteria by which the decision engine is to select the content (Courts, col. 7, lines 60-65).

18. Regarding claim 6, Courts disclosed the limitations, substantially as claimed, as described in claim 4, including wherein the document is a web page (Courts, col. 7, lines 28-33).

19. Regarding claims 7, 8, and 11, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein the content comprises at least one of text and an image that are determined to be appropriate for the client (Courts, col. 7, lines 28-33, Courts disclosed the document including web content, which are text and images) and wherein the content comprises formatting that is determined to be appropriate for the client (Courts, col. 8, lines 25-31, 43-48).

20. Regarding claim 10, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27. Claim 10 is nothing more than repeating the functionality of claim 9 with a third portion of the script. Therefore, claim 10 is rejected by the same art as claim 9 as being substantially similar.

21. Regarding claim 14, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including the act of the decision engine selecting the second portion of the script, including:

identifying, independently of a server application that executes the script, decision criteria that are to be used by the decision engine to select the second portion (Courts, col. 8, lines 35-45);

identifying, independently of a server application, the at least one attribute of the client that is to be used by the decision engine to select the second portion (Courts, col. 8, lines 35-45).

22. Regarding claim 15, Courts disclosed the limitations, substantially as claimed, as described in claim 14, including wherein the act of the decision engine selecting the second portion of the script further includes applying the decision criteria to the at least one attribute to select said second portion of script from among a plurality of portions of script (Courts, col. 8, lines 30-45).

23. Claims 28-33 include limitations substantially similar to the limitations of claims 1-15 and are therefore rejected by the same prior art used in the rejections of claims 1-15 as being substantially similar.

24. Regarding claim 34, Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein the decision engine includes decision criteria for identifying the content and wherein the server application is configured without the decision criteria that are used to identify the content (Courts, col. 8, lines 30-45).

25. Regarding claim 35 Courts disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 27, including wherein changes can be made to the decision criteria without altering code of the server application (Courts, col. 7, lines 30-45).

Claims 1-15 and 27-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Gebauer (U.S. 6,662,343).

26. Regarding claims 1, 9, 12, 13, and 27, Gebauer disclosed in a server included in a network that also includes a client associated with specified attributes, a method of using a decision engine to create a document for use by the client, the document being customized according to the specified attributes associated with the client, the method comprising the acts of:

receiving a request for a document at a server application, the server application being configured to generate the document from a script;

the server application generating a request for a decision engine, which is separate from the server application, to select content for the document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made;

the server application receiving from the decision engine an identification of the content that has been selected by the decision engine; and

transmitting the document to the client (Gebauer, Fig 5, col. 9, Abstract, Gebauer disclosed web server software **96** that receives a request from a client, the web server software 96 making a request through the Cool ICE Gateway **100** to the Service Handler **102**, which identifies content data/scripting from the Cool ICE Repository **106** and Cool Ice Scripting **108**, and generates web content, which is sent back to the web server software **100**, the web server software combining the content to form a complete response to the user).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

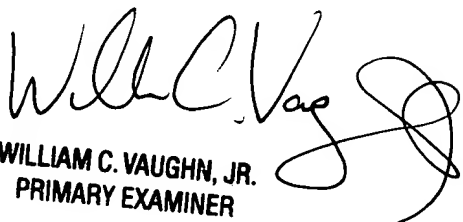
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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